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PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
5490-000244

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Application Number
10/082,514Filed
February 25, 2002First Named Inventor
Robert MetzgerArt Unit
3738Examiner
Dave WillseOn May 19, 2006

Signature

Typed or printed name Michael L. Taylor

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.

Registration number 31,251/50,521.

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Stephen J. Foss/Michael L. Taylor

Typed or printed name

(248) 641-1600

Telephone number

May 19, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/082,514
Filing Date: February 25, 2002
Applicant: Robert Metzger
Group Art Unit: 3738
Examiner: Dave Willse
Title: METHOD AND APPARATUS FOR MECHANICALLY
RECONSTRUCTING LIGAMENTS IN A KNEE PROSTHESIS
Attorney Docket: 5490-000244

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sirs,

Please consider the following five pages of Reasons for the Pre-Appeal Brief Review, starting on Page 2. The reasons are submitted as set out in the Official Gazette Notice of July 12, 2005 regarding the Pre-Appeal Brief Conference Pilot Program.

Summary

Applicant submits that there is clear error in the rejections made in the Office Action mailed January 19, 2006 and the Advisory Action mailed May 12, 2006 and that the rejections included therein omit one or more essential elements needed for a prima facie rejection.

Status of the Claims

The Advisory Action mailed May 12, 2006 indicated that the amendments to the claims in the Amendment filed on April 19, 2006 have not been entered. Thus, the claims stand as amended in the amendment mailed November 7, 2005. In that amendment, Claims 1-36 and 38-40 are pending, of which Claims 1, 13, 23, 24, 25, 32, 38, and 40 are independent. Claims 24, 25, 38, and 39 are allowed and are not part of this appeal, and each of the other claims stand rejected under 35 U.S.C. § 102(b) and § 103(a) in light of Moulin, as maintained in the Advisory Action mailed May 12, 2006.

Remarks and Arguments

Clear Error

In various responses and discussions with the Examiner, Applicant's representative has provided various reasons and arguments why the cited art, in particular Moulin, does not teach or fairly suggest each of the elements of the presently rejected claims including independent Claims 1, 13, 23, 32, and 40. Applicant submits that the rejections as they stand include clear error and omit at least one element of a prima facie reason for rejection.

Initially, Applicant submits that the Office Action mailed on January 19, 2006, which was immediately subsequent to filing a Request for Continued Examination by the Applicant, was improper. That Office Action was made Final although it was the first action mailed after the Request for Continued Examination and the claims were amended in an amendment filed with the Request for Continued Examination on November 7, 2005. Applicant submits that the finality of

the Office Action mailed January 19, 2006 is clear error because the claims were amended when the Request for Continued Examination was submitted (as discussed with the Examiner on September 28, 2005).

Prior to filing the Request for Continued Examination and the amendment therewith on November 7, 2005, Applicant's representative participated in a telephonic interview with the Examiner on September 28, 2005. During the interview, Applicant discussed the various amendments, including the amendments provided in the response filed November 7, 2005. During the interview, the Examiner indicated that independent Claim 1, as amended, appeared to distinguish over the cited art. For example, Claim 1 includes a monolithic bearing member and a monolithic tibial tray where the bearing member includes bearing surfaces to bear against the femoral component and tibial bearing surface. See 11-7-2005 Amend. p. 2. Independent Claim 13 also recites "a femoral component . . . a tibial component having a tibial bearing surface; a monolithic bearing member . . . wherein said bearing member is able to translate at least three of an anterior direction, a posterior direction, a medial direction, a lateral direction, and a rotational direction." See 11-7-2005 Amend. p. 5. The other independent claims such as Claims 23, 30 and 40 include recitations of subject matter similar to Claims 1 and 13 and should be allowed for similar reasons. For example, Independent Claim 30 includes a bearing member that has bearing surfaces to articulate with the femoral bearing surface and the tibial bearing surface.

Moulin is a French patent reference, of which an English translation was provided to Applicant with paper No. 7. Reference to Moulin herein is to the English translation provided to the Applicant with paper No. 7. Initially, Applicant reiterates the Remarks provided in the response filed by Applicant on November 7, 2005, particularly in pages 18-20 thereof.

In particular, Moulin does not teach or fairly suggest a monolithic bearing member or monolithic tibial tray. Moulin teaches a prosthesis system that requires numerous portions between a femoral component and a portion inserted into a tibial bone. Even assuming that any one of the elements illustrated in the figures of Moulin can be removed, there is still no monolithic

bearing member or a monolithic tibial tray provided to articulate with one another. See 11-7-2005 Amend. p.18, Ins. 10-21. For example, as illustrated in plate 1 of Moulin, the prosthesis includes a tibial element 2, a femoral element 1, an intermediate plate 5, a slide 3, and a shock absorbing plate 4 that is sandwiched between the tibial element 2 and an intermediate plate 5. See Moulin translation, p. 2, Ins. 12-21. Slide 3 is the only portion of the prosthesis disclosed in Moulin that can be eliminated. Further, the written description of Moulin discloses that, when natural ligament portions are destroyed, the slide 3 is often eliminated and artificial ligaments are used which are held in place by bars and screws. See Moulin translation, p. 6, Ins. 14-23.

Because of these teachings, Applicant submits that Moulin clearly does not anticipate or render obvious each of the elements of the presently pending independent claims. Claim 1 is directed to a monolithic tibial tray and a monolithic bearing member where the bearing member articulates with both a femoral component and a tibial component. Independent Claim 13 is directed to femoral and tibial components as well as a monolithic bearing that can translate in at least three directions. In addition, a linkage mechanism is included that controls relative movement of the femoral component and the tibial component. The combination of the elements of Claim 13 is not disclosed together in Moulin. In particular, Moulin fails to teach the combination of a monolithic bearing member than can translate in numerous directions, the femoral and tibial components, and the linkage mechanism as recited in Claim 13.

Moulin does not anticipate or fairly suggest a ball and socket linkage with a linkage mechanism. Moulin discloses using a block and screw mechanism to pressure fit the components together. See Moulin translation, p. 6, Ins. 14-23. The ligament replacements are required to be thin and broad to work with the block mechanism. Therefore, Moulin actually teaches away from a ball and socket linkage as recited in independent Claim 23. See 11-7-2005 Amend. p. 19, Ins. 3-18.

Applicant submits that Claims 32 and 40 are also clearly not anticipated or rendered obvious by Moulin, at least for the reasons stated above. For example, Moulin does not anticipate

or render obvious a bearing member that has a first bearing surface to articulate with a femoral bearing surface and a second bearing surface to articulate with a tibial bearing surface.

Thus, there is clear error in the Office Action rejecting each of the claims identified above. Moulin only teaches a femoral component, a tibial component, and a plurality of components that are positioned therebetween so that no more than one piece engages either the femoral component or the tibial component. Even assuming that one of the components can be removed, there remain two components between the tibial component and the femoral component, as discussed above. Even the artificial ligaments disclosed in Moulin do not anticipate or render obvious the linkage mechanism as recited in the various rejected claims. Applicants note that Moulin is the only reference cited in the Office Action mailed January 19, 2006 to reject each of the claims. Although the Advisory Action mailed May 12, 2006 appears to discuss both the Moulin and Simpson references, Applicant notes that no rejection has been made using Simpson.

Therefore, Applicant submits that there is clear error in the rejections that made in the Office Action mailed January 19, 2006 and maintained in the Advisory Action. Further, the Amendment filed April 19, 2006 was filed only after an interview with the Examiner on April 7, 2006. During the interview on April 7, 2006 with Applicant's representative, the differences between Moulin and several of the pending independent claims were discussed. During the interview, Applicant's representative reiterated that various elements of the claims are not taught by Moulin and discussed with the Examiner additional clarifying language that may be acceptable to overcome the rejections. During the interview, the amendments made and filed on April 19, 2006 were discussed with the Examiner and were made only to re-state the recitations of the various independent claims. Therefore, Applicant submits that the amendments provided in the Amendment mailed April 19, 2006 further support the position maintained by the Applicant herein.

Omission Of An Element For A Prima Facie Rejection

The clear error, summarized above, leads to the omission of an element required for a prima facie rejection. The omission of an element for a prima facie rejection is clear because the references cited in the Office Action do not anticipate or fairly suggest and render obvious each of the elements in the presently pending claims, including the presently pending independent claims. Thus, there are no proper grounds for the rejections. Applicant further submits that the rejection of the dependent claims based upon Moulin is also improper. Applicant submits that various recitations in the dependent claims are also patentable in light of Moulin and should also be allowed.

Conclusion

Applicant submits that the rejections presently maintained by the Examiner are improper, based upon a clear error, and do not meet a prima facie case for rejection. The position of the Applicant remains substantially unchanged from the various responses filed in the present Application, including those filed November 7, 2005 and April 19, 2006. Accordingly, in light of the clear error and the lack of a prima facie case for the rejections, Applicant requests that the Panel review the rejections and direct the Examiner to withdraw each of the rejections and to allow each of the presently pending claims.

Respectfully submitted,

Dated: 5/19/06
HARNES, DICKEY & PIERCE, P.L.C.
P.O. Box 828
Bloomfield Hills, Michigan 48303
(248) 641-1600

By: Stephen J. Foss
Stephen J. Foss
Reg. No. 31,251
Michael L. Taylor
Reg. No. 50,521

SJF/MLT/jb